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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RIMELL, SAMUEL G

ART UNIT

PAPER NUMBER

2175

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,097

Applicant(s)

PROVOST ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

SAM RIMELL

PRIMARY EXAMINER

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-35 are rejected under the judicially created doctrine of double patenting over claims 1-27 of U. S. Patent No. 6,341,265 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The provision of systems, methods and program code for receiving diagnosis and treatment code from a client computer as part of an insurance claim, determining whether the claim is in condition to be paid, transmitting an indication that a claim is in condition to be paid, however, if it determined that the claim is not in condition to be paid, sending one of a revised diagnosis or treatment code back to the client computer.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is meant by the phrase "consistent with an unbundling claim practice". The "unbundling" discussed in the specification refers to actions of physicians performing multiple procedures on one patient. However, claim 23 is referring to decisions made by the insurance company, not medical actions by the physician.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5-13 and 15-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyer et al. ('973).

Claim 1: Reference is made to col. 13, lines 9-56 and col. 14, line 44 of Boyer et al.

client computer at the physician's office receives entry by the physician of diagnosis information, which reads as a diagnosis code. This information also appears to include the entry by the physician of treatment codes, since col. 14, line 44 refers to the receipt of "CPT codes" which are codes that correspond to medical procedures. The information is entered by the physician prior to treatment of the patient. The physician transmits through the Internet a preliminary claim that includes the diagnosis code and treatment code. At a remote server (16. 22) a decision is made as to whether the diagnosis code and treatment code correspond to health

care services approved by the server. The server then returns information back to the client computer, prior to performing the health care services, indicating whether any medical services are approved for payment and exactly which services would be approved for payment. The last paragraph of claim 1 is recited in the form of an optional method step, and thus is not limiting the claim. Thus, the steps of returning a revised claim including one of revised diagnosis code or treatment code is not mandatory, and thus is not required to be taught by Boyer et al.

Claim 2: If the diagnosis and treatment codes submitted by the physician do not correspond to approved services, this would be indicated to the physician.

Claim 5: The physician transmits the information to the server (16,22) via the Internet. Since hypertext markup language is a universal standard for document transmittal over the Internet, this feature would be inherent to the system of Boyer et al., which explicitly recites the Internet and transmitting documents over the Internet.

Claim 6-7: The transmission of information to the server (16, 22) and return of information by the server occurs during the time period that the physician is on-line. This is consistent with the "single period of time" being claimed.

Claim 8: The physician can use the system of Boyer et al. for any number of patients. Thus, for a second patient, repeating the process by transmitting a second set of diagnosis and treatment codes to the server (16, 22) and receiving a second set of information in reply from the server is within the scope of the Boyer et al. reference.

Claim 9: The physician receives an indication of the amount they are to be paid (col. 15, lines 5-6).

Claim 10: The physician receives an indication of the co-payment due from the patient (col. 15, line 4).

Claim 11: The physician receives and processes the patient's insurance card, which also may include a VISA credit card feature (col. 6, lines 40-45) to pay for any co-payment which is due from the patient.

Claim 12: The physician receives and process the patient's insurance card while the patient is in the physician's office.

Claim 13: See remarks for claim 1.

Claim 15: See remarks for claims 6-7.

Claim 16: A patient ID may also be transmitted by the client computer operated by the physician (col. 13, line 11).

Claim 17: The receipt by the physician of information on approved procedures for a specific patient is indication that the patient identified by the patient ID is covered by insurance.

Claim 18: See remarks for claim 1.

Claim 19: Col. 13, line 30 refers to the presence of an electronic claim application. Prior to the performance of a medical procedure, the physician fills out the electronic claim application with a diagnosis code and treatment code and transmits the application to the server, which replies with information on which medical services if any, are approved. The information is inherently entered into fields on the claim application, otherwise, there would be no way to enter information on the application.

Claim 20: See remarks for claim 5.

Claim 21: See remarks for claims 6-7.

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Claim 22: Col. 8, lines 27-42 describe a policy database from which information is collected to determine which procedures are approved.

Claim 23: As best as can be understood from the meaning of this claim, the system of Boyer et al. is not limited to consideration of a single medical procedure on a single patient, and could address multiple procedures performed on a single patient when analyzing the insurance claims.

Claims 24-35 would be allowable if the non-statutory double patenting rejection is overcome. Claims 3, 4 and 14 would be objected to if this rejection is overcome.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
Art Unit 2175